

REMARKS

Applicant thanks the Examiner for carefully considering the submission filed on August 30, 2007 ("Submission"), and this supplement amendment to the Submission.

Basis of Amendments and Remarks

This supplemental amendment is based on entry of Submission (including amendments made therein).

Disposition of Claims

Claims 14-19 and 21 are pending in the referenced application. By way of this reply, claim 22-24 have been cancelled, without prejudice or disclaimer. Accordingly, claims 14-19 and 21 are now pending in the referenced application. Claims 14 and 21 are independent. The remaining claims depend, directly or indirectly, from independent claim 14.

Claim Amendments

Claims 14 has been amended to clarify various aspects to the invention. Support for the aforementioned amendment is present, for example, in original claim 11. Further, claims 17-19 have been amended to address antecedent basis issues arising from the amendment to independent claim 14. No new matter has been added by any of the aforementioned amendments.

Rejections under 35 U.S.C. §101

Claims 22-24 stand rejected under 35 U.S.C. § 101 for failing to recite statutory subject matter. Claims 22-24 have been cancelled by this reply. Accordingly, this rejection is now moot with respect to claims 22-24. Withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. §112

Claims 14-24 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Claims 22-24 have been cancelled by this reply. Accordingly, this rejection is now moot with respect to claims 22-24¹. Accordingly, this rejection is now moot with respect to cancelled claim 20. With respect to claims 14-19 and 21, the rejection is respectfully traversed.

The Examiner has asserted that the term "synchronization object" is not described in the specification to enable one of ordinary skill in the art to make or use the invention as claimed. The Applicant disagrees. First, the specification provides a definition for the term at p. 8, l. 28- p.9, l.1. The specification then provides a detailed discussion of how the synchronization object may be used on at least pages 5, 6, and 8.

Second, the Applicant asserts that the above disclosure satisfies the requirements outlined in MPEP § 2164.01(c), which states:

If a statement of utility in the specification contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are known and contemplated, 35 U.S.C. 112 is satisfied. *In re Johnson*, 282 F.2d 370, 373, 127 USPQ 216, 219 (CCPA 1960); *In re Hitchings*, 342 F.2d 80, 87, 144 USPQ 637, 643 (CCPA 1965). See also *In re Brana*, 51 F.2d 1560, 1566, 34 USPQ2d 1437, 1441 (Fed. Cir. 1993).

¹ Claim 20 was previously cancelled in the Submission.

In view of the above, claims 14-19 and 21 are enabled. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph for lacking antecedent basis. The rejection is respectfully traversed. Specifically, the term “program” is first used in dependent claim 17. Accordingly, the term is preceded by an “a.” Thus, the term “program” has sufficient antecedent basis and, accordingly, withdrawal of this rejection is respectfully requested.

Claim 22 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claim 22 has been cancelled by this reply. Accordingly, this rejection is now moot and withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 102

Claims 14-16 and 21-24 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent No. 2003/0037020 (“Novak”). Claims 22-24 have been cancelled by this reply. Accordingly, this rejection is now moot with respect to claims 22-24. To the extent that this rejection applies to the amended claims, the rejection is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131. Applicant asserts that Novak fails to disclose all of the limitations of amended independent claim 14.

Specifically, amended independent claim 14 recites, in part, “generating, by the removable subscriber identity module, a new synchronization object associated with the first database when the removable subscriber identity module receives a request that the new

synchronization object be associated to the first database” (emphasis added). The above limitations require that the removable subscriber identity module (*e.g.*, the SIM card (CAR)) and not the mobile phone (*e.g.*, MOB), generates the synchronization object.

In contrast, Novak discloses that the checksum (which the Examiner equates to the claimed synchronization object) is generated by the processor (*see e.g.*, claims 13-16²). Because Novak fails to disclose the generation of the checksum in the removable subscriber identity module, Novak fails to disclose all the limitations of amended independent claim 14. Thus, amended independent claim 14 is patentable over Novak. Dependent claims are patentable over Novak for at least the same reasons as the aforementioned independent claims. Accordingly, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak in view of U.S. Patent No. 6,968,209 (“Ahlgren”). Claims 17 and 18 depend from amended independent claim 14. This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 2143. Applicant asserts that Novak and Ahlgren fail to teach or suggest all the claim limitations.

As discussed above, Novak fails to teach or suggest all the limitations of amended independent claim 14. Further, Ahlgren fails to disclose that which Novak lacks as evidenced by the fact that Ahlgren is only relied upon to teach the limitations of claim 17 and 18. *See Office*

² Novak does not include any additional information about where the checksum is calculated.

Action mailed May 30, 2007, pp. 19-20. Moreover, Ahlgren is silent with respect to "generating, by the removable subscriber identity module, a new synchronization object..."

In view of the above, Novak and Ahlgren, whether considered separately or in combination, fail to teach or suggest all the limitation of amended independent claim 14. Thus, amended independent claim 14 is patentable over Novak and Ahlgren. Dependent claims 17 and 18 are patentable over Novak and Ahlgren for at least the same reasons as amended independent claim 14. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak in view of Applicant Admitted Prior Art (AAPA). Claim 20 has been cancelled by this reply. Accordingly, this rejection is now moot with respect to cancelled claim 20. With respect to claim 19, the rejection is respectfully traversed. Claim 19 depends from amended independent claim 14. This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143. Applicant asserts that Novak and Ahlgren fail to teach or suggest all the claim limitations.

As discussed above, Novak fails to teach or suggest all the limitations of amended independent claim 14. Further, AAPA fails to disclose that which Novak lacks as evidenced by the fact that AAPA is only relied upon to teach the limitations of claims 19 and 20. *See* Office Action mailed May 30, 2007, p. 21. Moreover, Ahlgren is silent with respect to "generating, by the removable subscriber identity module, a new synchronization object..."

In view of the above, Novak and AAPA, whether considered separately or in combination, fail to teach or suggest all the limitation of amended independent claim 14. Thus,


amended independent claim 14 is patentable over Novak and AAPA. Dependent claim 19 is patentable over Novak and AAPA for at least the same reasons as amended independent claim 14. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number: 09669/046001).

Dated: September 6, 2007

Respectfully submitted,

By  #45,079
Jonathan P. Osha THOMAS SCHERER
Registration No.: 33,986
OSHA · LIANG LLP
1221 McKinney St., Suite 2800
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant